

PROCEDURE IN INTER PARTES
PROCEEDINGS

AUTHORITY: Secs. 2.116 to 2.136 also issued under sec. 17, 60 Stat. 434; 15 U.S.C. 1067.

§ 2.116 Federal Rules of Civil Procedure.

(a) Except as otherwise provided, and wherever applicable and appropriate, procedure and practice in inter partes proceedings shall be governed by the Federal Rules of Civil Procedure.

(b) The opposer in an opposition proceeding or the petitioner in a cancellation proceeding shall be in the position of plaintiff, and the applicant in an opposition proceeding or the respondent in a cancellation proceeding shall be in the position of defendant. A party that is a junior party in an interference proceeding or in a concurrent use registration proceeding shall be in the position of plaintiff against every party that is senior, and the party that is a senior party in an interference proceeding or in a concurrent use registration proceeding shall be a defendant against every party that is junior.

(c) The opposition or the petition for cancellation and the answer correspond to the complaint and answer in a court proceeding.

(d) The assignment of testimony periods corresponds to setting a case for trial in court proceedings.

(e) The taking of depositions during the assigned testimony periods corresponds to the trial in court proceedings.

(f) Oral hearing corresponds to oral summation in court proceedings.

[30 FR 13193, Oct. 16, 1965. Redesignated and amended at 37 FR 7606, Apr. 18, 1972; 48 FR 23136, May 23, 1983]

§ 2.117 Suspension of proceedings.

(a) Whenever it shall come to the attention of the Trademark Trial and Appeal Board that parties to a pending case are engaged in a civil action which may be dispositive of the case, proceedings before the Board may be suspended until termination of the civil action.

(b) Whenever there is pending, at the time when the question of the suspension of proceedings is raised, a motion which is potentially dispositive of the

case, the motion may be decided before the question of suspension is considered.

(c) Proceedings may also be suspended, for good cause, upon motion or a stipulation of the parties approved by the Board.

[48 FR 23136, May 23, 1983]

§ 2.118 Undelivered Office notices.

When the notices sent by the Patent and Trademark Office to any registrant are returned to the Office undelivered, or when one of the parties resides abroad and his representative in the United States is unknown, additional notice may be given by publication in the *Official Gazette* for such period of time as the Commissioner may direct.

§ 2.119 Service and signing of papers.

(a) Every paper filed in the Patent and Trademark Office in inter partes cases, including notice of appeal, must be served upon the other parties except the notice of interference (§ 2.93), the notification of opposition (§ 2.105), the petition for cancellation (§ 2.113), and the notice of a concurrent use proceeding (§ 2.99), which are mailed by the Patent and Trademark Office. Proof of such service must be made before the paper will be considered by the Office. A statement signed by the attorney or other authorized representative, attached to or appearing on the original paper when filed, clearly stating the date and manner in which service was made will be accepted as prima facie proof of service.

(b) Service of papers must be on the attorney or other authorized representative of the party if there be such or on the party if there is no attorney or other authorized representative, and may be made in any of the following ways:

(1) By delivering a copy of the paper to the person served;

(2) By leaving a copy at the usual place of business of the person served, with someone in the person's employment;

(3) When the person served has no usual place of business, by leaving a copy at the person's residence, with a member of the person's family over 14 years of age and of discretion;

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(4) Transmission by the “Express Mail Post Office to Addressee” service of the United States Postal Service or by first-class mail, which may also be certified or registered;

(5) Transmission by overnight courier.

Whenever it shall be satisfactorily shown to the Commissioner that none of the above modes of obtaining service or serving the paper is practicable, service may be by notice published in the *Official Gazette*.

(c) When service is made by first-class mail, “Express Mail,” or overnight courier, the date of mailing or of delivery to the overnight courier will be considered the date of service. Whenever a party is required to take some action within a prescribed period after the service of a paper upon the party by another party and the paper is served by first-class mail, “Express Mail,” or overnight courier, 5 days shall be added to the prescribed period.

(d) If a party to an inter partes proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, the party must designate by written document filed in the Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in the proceeding. In such cases, official communications of the Patent and Trademark Office will be addressed to the domestic representative unless the proceeding is being prosecuted by an attorney at law or other qualified person duly authorized under § 10.14(c) of this subchapter. The mere designation of a domestic representative does not authorize the person designated to prosecute the proceeding unless qualified under § 10.14(a), or qualified under paragraph (b) or (c) of § 10.14 and authorized under § 2.17(b).

(e) Every paper filed in an inter partes proceeding, and every request for an extension of time to file an opposition, must be signed by the party filing it, or by the party’s attorney or other authorized representative, but an unsigned paper will not be refused consideration if a signed copy is submitted to the Patent and Trademark Office

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within the time limit set in the notification of this defect by the Office.

[37 FR 7606, Apr. 18, 1972, as amended at 41 FR 760, Jan. 5, 1976; 54 FR 34898, Aug. 22, 1989; 54 FR 38041, Sept. 14, 1989]

§ 2.120 Discovery.

(a) *In general.* The provisions of the Federal Rules of Civil Procedure relating to discovery shall apply in opposition, cancellation, interference and concurrent use registration proceedings except as otherwise provided in this section. The Trademark Trial and Appeal Board will specify the closing date for the taking of discovery. The opening of discovery is governed by the Federal Rules of Civil Procedure.

(b) *Discovery deposition within the United States.* The deposition of a natural person shall be taken in the Federal judicial district where the person resides or is regularly employed or at any place on which the parties agree by stipulation. The responsibility rests wholly with the party taking discovery to secure the attendance of a proposed deponent other than a party or anyone who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure. See 35 U.S.C. 24.

(c) *Discovery deposition in foreign countries.* (1) The discovery deposition of a natural person residing in a foreign country who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, shall, if taken in a foreign country, be taken in the manner prescribed by § 2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders or the parties stipulate, that the deposition be taken by oral examination.

(2) Whenever a foreign party is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, such party may be deposed by oral examination upon notice by the party seeking discovery. Whenever a foreign party has or will have, during a